

ESTTA Tracking number: **ESTTA127829**

Filing date: **03/02/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	McDonald's Corporation
Granted to Date of previous extension	03/04/2007
Address	One McDonald's Plaza Oak Brook, IL 60523-1900 UNITED STATES

Correspondence information	John Anthony Cullis Attorney of Record Neal, Gerber & Eisenberg LLP Two North LaSalle Street Suite 2200 Chicago, IL 60602 UNITED STATES rbrowne@ngelaw.com, jcullis@ngelaw.com, mkelber@ngelaw.com Phone:312-269-8000
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### Applicant Information

Application No	78792269	Publication date	09/05/2006
Opposition Filing Date	03/02/2007	Opposition Period Ends	03/04/2007
Applicant	Macbar LLC 19 East 80th Street, #4-B New York, NY 10021 UNITED STATES		

### Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Restaurants
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Attachments	MacBar - Notice of Opposition.pdf ( 8 pages )(312693 bytes )
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Signature	/john a. cullis/
Name	John Anthony Cullis
Date	03/02/2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:  
Application Serial No. 78/792,269  
Published in the *Official Gazette*  
September 5, 2006

McDONALD'S CORPORATION,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
MACBAR, LLC,	)	
	)	
Composed of Odell Lambroza and	)	
Mark Amadei	)	
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Opposer, McDONALD'S CORPORATION ("Opposer"), a corporation organized and existing under the laws of the State of Delaware, with offices at One McDonald's Plaza, Oak Brook, Illinois 60523-1900, believes that it will be damaged by registration of the mark "MACBAR" in International Class 43, as shown in Application Serial No. 78/792269 filed by Applicant, MacBar, LLC, composed of Odell Lambroza and Mark Amadei ("Applicant"), a New York limited liability company, located at 19 East 80<sup>th</sup> Street, Unit 4-B, New York, New York 10021, and hereby opposes the same and requests that registration to Applicant be refused.

As grounds for its opposition, Opposer alleges that:

1. Applicant seeks to register a mark that consists of the term "MACBAR" for "restaurants" in International Class 43 (hereinafter, the "MACBAR" mark). The application is an intent-to-use based application under 15 U.S.C. § 1051(1)(b).
2. Opposer has filed this Notice of Opposition in a timely fashion.

3. Since 1955, Opposer has been in the business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a wide variety of high quality, quickly-prepared, modestly-priced foods. Opposer has carried on this business throughout the United States and the world. Opposer and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 13,000 restaurants in the United States.

4. In connection with this business, Opposer extensively uses the “Mc” and “Mac” formatives with various generic or descriptive terms as trademarks and service marks in advertising, promoting and selling a wide variety of food products and restaurant services. In particular, Opposer has used its world famous “McDONALD’S,” “RONALD McDONALD” and “BIG MAC” trademarks in connection with various goods and services for over fifty years. In that time, Opposer has expanded the use of its “Mc” and “Mac” family of trademarks to include a wide variety of goods and services including, but not limited to: pizza, chili, muffins, specialty sandwiches, dessert products, salads, chicken sandwiches, beverages, bagels, computer programs and games, children’s clothing, computer tables, newsletters, as well as several other goods and services, which are advertised and promoted in connection with its restaurants nationwide.

5. Opposer’s extensive advertising and promotion of its various goods and services under its family of “Mc” and “Mac” formative marks features the use of television and print advertising, radio, newspaper and magazine advertising, outdoor billboard, Internet advertising and direct mail, which are directed to and reach the public in both local and nationwide markets. In addition, Opposer uses the “Mc” and “Mac” formative family of marks on food product packaging and point of purchase advertising. In sum, Opposer uses the “Mc” and “Mac” family of marks on a wide variety of products and services, including services that are identical to those for which the “MACBAR” mark is intended to be used by Applicant.

6. In particular, Opposer owns a federal registration on the mark “Mc,” Registration No. 1,947,099, issued on January 9, 1996, for restaurant services. Opposer additionally owns numerous federal registrations for its family of “Mc” and “Mac” marks for various goods or services, including many that are related to restaurant services, as illustrated by the following:

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
1.	BIG MAC	1,126,102	10/16/79	Sandwich
2.	BIG MAC	1,331,342	04/16/85	Restaurant services
3.	BIG MAC	1,596,524	05/15/90	Children’s clothing, namely t-shirts
4.	BIG MAC	2,356,974	06/13/00	Halloween costumes for adults and children
5.	BIG MAC	2,742,248	07/29/03	Men’s and women’s clothing not including work clothing
6.	BIG MAC	2,035,287	02/04/97	Sandwich for consumption on or off the premises
7.	BIG MAC LAND	2,484,246	07/04/01	Restaurant services
8.	BIG MAC ATTACK	1,112,501	01/30/79	Restaurant services
9.	OFFICER MAC	1,695,886	06/23/92	Robots for scientific and educational purposes
10.	MACLIBRARY	1,420,838	12/16/86	Computer programs prerecorded on magnetic disks and related instructional manuals sold as a unit
11.	MAC ATTACK	1,654,388	08/20/91	Clothing – namely shirts, jackets and pants
12.	MAC FRIES	1,307,293	11/27/84	Frozen french fried potatoes
13.	MacVEGAS	1,353,036	08/06/85	Prerecorded computer game programs
14.	MAC TONIGHT	1,482,041	03/22/88	Restaurant services
15.	MAC JR.	2,461,113	06/19/01	Restaurant services
16.	MAC JR.	2,461,112	06/19/01	Sandwiches for consumption on or off the premises
17.	MORNING MAC	1,911,980	08/15/95	Restaurant services

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
18.	MORNING MAC	1,911,629	08/15/95	Specialty Sandwich for consumption on or off the premises
19.	McKIDS	1,489,334	05/24/88	Backpacks, purses, children's and infant's clothing and accessories; bib pants, pajamas, jumpers, rainwear, snowsuits, shorts, underwear, belts, boots, gloves, shoes, slippers, socks, suspenders, etc.
20.	McCLIP	1,579,598	01/23/90	Barbershop services
21.	McGIFT	2,435,272	03/13/01	Wrapping paper, paper gift bags, paper ribbons, bows
22.	McMERCHANDISE	1,878,115	02/07/95	Mail order services featuring novelty items
23.	McGIFT SHOP	1,566,577	11/14/89	Retail gift shop services
24.	McNATURE TRAIL	1,591,375	04/10/90	Providing recreational facilities for nature trips
25.	McMOMS	1,874,650	01/17/95	General interest magazines for consumers
26.	McPRODUCT	1,635,845	02/19/91	Mail order services in the field of promotional novelty items
27.	McSTUFF STORE	1,530,317	03/14/89	Retail gift shop services
28.	McSHIRT	1,592,145	04/17/90	Men's clothing, women's clothing and children's clothing; t-shirts and sweatshirts
29.	McBUDDY	1,926,019	10/10/95	Non-monetary charitable services; providing foods, clothing, school supplies, and the like to underprivileged children and families
30.	McPREP	1,908,924	08/01/95	Educational services; conducting classes, seminars, conferences, and workshops
31.	McSHUTTLE	1,418,655	11/25/86	Transportation services; providing ground

<u>EXHIBIT</u>	<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
32.	McJOBS	1,358,486	09/03/85	transportation services Training handicapped persons as restaurant employees
33.	McLODGE	1,562,702	10/24/89	Hotel services
34.	MAKE IT MAC TONIGHT M MCDONALD'S	1,525,841	02/21/89	T-shirts, baseball hats, visors, sweatshirts, and aprons

These registrations are valid, subsisting, and in full force and effect.

7. With the exception of those marks that have been registered less than six years, each of the foregoing registrations is incontestable under § 1065 of the Lanham Act, providing conclusive evidence under § 1115(b) of the validity of the registration of the mark and Opposer's ownership and exclusive right to use the mark in commerce.

8. In addition, Opposer owns numerous other federal registrations of its "Mc" and "Mac" formative marks for a variety of goods and services.

9. Both the Trademark Trial and Appeal Board and the Federal Circuit have long recognized Opposer's rights in its famous "Mc" and "Mac" family of marks. McDonald's Corp. v. McKinley, 13 U.S.P.Q.2d 1895, 1899 (TTAB 1989)(In finding that the mark "McTEDDY" was likely to cause confusion with McDonald's "Mc" and "Mac" family of marks, the Board stated, "In view of opposer's extensive evidence of use and promotion of marks having a "Mc" or "Mac" portion, there can be no doubt that opposer has established that its marks comprise a family"); McDonald's Corp. v. McBagle's, Inc., 649 F.Supp. 1268, 1272 (S.D.N.Y. 1986) (In finding that the mark "McBAGEL" was confusingly similar to McDonald's family of "Mc" and "Mac" marks, the court showed no hesitation in finding that McDonald's "owns a 'family of marks' both registered and unregistered, whose common characteristic is the use of 'Mc' or 'Mac' as a formative"); McDonald's Corp. v. McClain, 37 U.S.P.Q.2d 1274, 1276 (TTAB 1995)(In holding that the mark "McCLAIM" was confusingly similar to McDonald's "Mc"

formative marks, the Board stated, “The family of [McDonald’s] marks has been recognized by this Board and by the courts”); J&J Snack Foods Corp. v. McDonald’s Corp., 932 F.2d 1460 (Fed. Cir. 1991)(the court found that the marks, “McPRETZEL” and “McDUGAL McPRETZEL” were confusingly similar to McDonald’s “Mc” and “Mac” family of marks). Moreover, the court in McDonald’s Corp. v. Druck and Gerner, DDS., P.C., 814 F. Supp. 1127, 1134 (N.D.N.Y. 1993), found that the use of the term “McDENTAL,” in connection with dental services, infringed Opposer’s family of marks, and issued an injunction against the defendants.

10. Through Opposer’s extensive and continuous use of the name “McDONALD’S,” “RONALD McDONALD,” “BIG MAC,” and its family of “Mc” and “Mac” marks, the public has come to recognize marks combining “Mc” or “Mac” with a common word for goods and services as being uniquely associated with Opposer. In fact, the “Mc” and “Mac” formatives are so similar in appearance, sound and pronunciation that they have the same significance when viewed by the public. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to its family of “Mc” and “Mac” marks.

11. Despite Opposer’s long-standing prior rights in the name “McDONALD’S,” its “BIG MAC” mark and its family of “Mc” and “Mac” marks, Applicant filed its application to register the “MACBAR” mark, Serial No. 78/792269.

12. The mark Applicant seeks to register has as its only distinctive element the “MAC” prefix, which is coupled with the generic term “BAR”. Potential purchasers, upon seeing the dominant formative “MAC” in Applicant’s “MACBAR” mark used in connection with restaurant services, are likely to mistakenly believe that such term and the goods offered thereunder originated with or are connected with, sponsored or associated by, or licensed or endorsed by Opposer. Thus, the registration and use by Applicant of the “MACBAR” mark in connection with its proposed services is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1114(1)(a).

13. In addition, Opposer's rights in its "Mc" and "Mac" family of marks based on its use, registration and recognition by the public were established, and Opposer's "Mc" and "Mac" family was famous, long before Applicant filed the subject Application. Thus, registration to Applicant would diminish and dilute the distinctive quality of McDonald's rights in its family of famous "Mc" and "Mac" marks, in violation of 15 U.S.C. § 1125(c), and could also, in the event of any mishaps involving, or poor quality of, the goods offered by Applicant, tarnish such distinctiveness.

14. In light of Opposer's widespread advertising, promotion and resulting fame of its family of "Mc" and "Mac" formative marks, Applicant's selection of a term nearly identical and confusingly similar to Opposer's pre-existing family of "Mc" and "Mac" marks – for use in connection with the services that Opposer is renowned for, namely, restaurant services – suggests that Applicant intends to trade off the goodwill and recognition associated with Opposer's family of "Mc" and "Mac" marks.

15. If a registration is issued to Applicant for the "MACBAR" mark, the resulting confusion with Opposer's marks would cause damage and injury to Opposer and the public. Registration of this term would give Applicant an unqualified right to wrongfully appropriate Opposer's valuable goodwill and reputation associated with Opposer's marks and to benefit from such confusion among purchasers led to believe that Applicant's goods are related in some fashion to Opposer. Registration of this term to Applicant would also dilute the distinctiveness of Opposer's marks and harm its goodwill and reputation associated with its marks by allowing any fault with or objection to Applicant's goods to reflect upon Opposer, and would restrict the natural growth and expansion of Opposer's "BIG MAC" mark and entire family of "Mc" and "Mac" marks.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 78/792269 be refused registration.



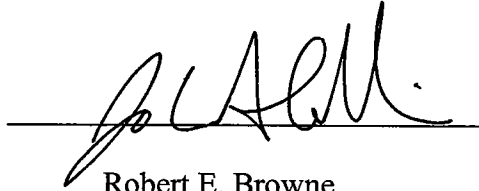
Please charge the fee of \$300 and any additional fees related to this matter to Deposit  
Account No. 502261.

Respectfully submitted,

McDONALD'S CORPORATION

Date: March 2, 2007

By:

A handwritten signature in black ink, appearing to read "R. Browne", is written over a horizontal line.

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